

REMARKS

Claims 1-8 are pending in the above-identified application. Claims 1-5 have been amended in order to correct some minor grammatical and spelling errors, as well as to place these claims into better form for consideration by the Patent Examiner. Support for new claim 6 is found at the top of page 5 of the specification. Support for new claims 7 and 8 is found at page 3, lines 11-18 of the specification. The specification has also been amended so as to make some minor spelling corrections.

Re-Submission of Information Disclosure Statement

Submitted with this Amendment is an Information Disclosure Statement (IDS) which includes copies of the references cited therein. This IDS corresponds to the IDS submitted when the present application was filed and which has not yet been considered by the Examiner.

Removal of Basis for Claim Objections and Issues under 35 USC 112

Claims 1 and 2 have been objected to because of the misspelled term "N-glyceryl". The spelling of this term has been corrected in the claims.

Claim 1 has been rejected under 35 USC 112, second paragraph as alleging being indefinite because of the use of "represented". This term has been removed from the present claims.

It is submitted that the basis for the above-noted objections and rejections have been removed such that these objections and rejections should be withdrawn.

Issues under 35 USC 103(a)

Claims 1-5 have been rejected under 35 USC 103(a) as being unpatentable over Kobayashi '346 (JP 2002/03346) in view of Yokoi '688 (JP 11/322688). This rejection is traversed based on the following reasons.

Kobayashi '346 discloses a permanent wave-treating agent for hair treatment which includes an arginine derivative represented by formula (1). As shown in the enclosed copy of the English abstract and English machine translation of Kobayashi '346, formula (I) includes substituent R^1 which is an alkyl group or alkenyl group that contains at least six carbon atoms and is bonded to a carbon atom. Kobayashi '346 discloses in paragraph [0004] of the machine translation that the arginine derivative is "an amphoteric surface active agent." In this regard, it is noted that an amphoteric surface active agent requires both a hydrophilic group and a hydrophobic group. As is evident from a review of formula (1), the R^1 group is the hydrophobic group present in the described derivative.

Kobayashi '346 fails to disclose or suggest any compounds falling within the scope of formula (I) of the present claims. Specifically, the present claims do not include any substituent corresponding to R^1 as required in formula (1) of the arginine derivative of Kobayashi '346. Further, Kobayashi '346 fails to provide any basis for a motivation to suggest to one skilled in the art to significantly modify the structure of formula (1) in order to obtain the N-glyceryl compounds of formula (I) as recited in the present claims. Consequently, significant patentable distinctions exist between the present invention and Kobayashi '346 such that this basis fails to support the allegation of non-obviousness and should be withdrawn.

Yokoi '688 discloses N-acylamino acid compound of formula (1) wherein substituent R^1 is an alkyl, alkenyl or hydroxyalkyl group having 7-21 carbon atoms. Yokoi '688 discloses in paragraph [0004] of the enclosed machine translation that the described N-acylamino acid is a surface active agent. This is the reason for the presence of the substituent R^1 in formula (1).

Yokoi '688 fails to disclose or suggest any compounds falling within the scope of formula (I) of the present claims. Specifically, the present claims do not include any substituent corresponding to R^1 as required in formula (1) of the compounds of Yokoi '688. Further, Yokoi '688 fails to provide any basis for a motivation to suggest to one skilled in the art to significantly modify the structure of formula (1) in order to obtain the N-glyceryl compounds of formula (I) as recited in the present claims. It is additionally noted that the mention of the dihydroxy propyl

group in paragraph [0004] of the machine translation of Yokoi '688 is in the context of the entire N-acylamino acid structure of formula (1) and does not constitute a suggestion that this specific functional group is responsible alone for being "mild on the skin"; but rather the entire chemical structure of formula (I) is responsible for the described properties. Consequently, significant patentable distinctions exist between the present invention and Yokoi '688 such that this basis fails to support the allegation of non-obviousness and should be withdrawn.

In addition to the above, it is submitted that there fails to be any reasonable basis for a motivation or suggestion to one skilled in the art to replace the alkyl group of Kobayashi '346 with the dihydroxy propyl group of Yokoi '688 for several reasons. First, as noted above, a correct interpretation of Yokoi '688 does not suggest to one skilled in the art that either the dihydroxy propyl group is entirely responsible for a mild or good feel on the skin or that this functional group can be easily separated from the rest of the chemical structure and attached to the structure of an entirely different compound, such as the compounds described by Kobayashi '346. The attempt to make this modification is based entirely on prohibited "hindsight reconstruction". In this regard, it is very unclear as to exactly how one skilled in the art would synthesize this type of hybrid compound based on the disclosures of Kobayashi '346 and Yokoi '688, without reference to the disclosure of the present application. In the end, the attempts to reconstruct the chemical structures of the compounds of Kobayashi '346 and Yokoi '688 in order to hypothetically obtain the compounds of formula (I) recited in the present claims fail to be based on any suggestion of the desirability of the presently claimed invention and are merely attempts to allege these references can be combined or modified in the absence of an appropriate suggestion of the desirability for the combination or modification, which falls short of establishing *prima facie* obviousness. *In re Mills*, 916 F.2d 68, 16 USPQ2d 1430 (Fed. Cir. 1990). Consequently, significant patentable distinctions exist between the present claims and each of the above-discussed references, whether taken separately or inappropriately combined.


It is submitted for the reasons above that the present claims define patentable subject matter such that this application should now be placed in condition for allowance.

If any questions arise in the above matters, please contact Applicant's representative, Andrew D. Meikle (Reg. No. 32,868), in the Washington Metropolitan Area at the phone number listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

By 

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Enclosures: English machine translation of Kobayashi '346 and Yokoi '688
Information Disclosure Statement